

1           The opinion in support of the decision being entered today was  
2     *not* written for publication and is *not* binding precedent of the Board.  
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5           UNITED STATES PATENT AND TRADEMARK OFFICE  
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8                   BEFORE THE BOARD OF PATENT APPEALS  
9                   AND INTERFERENCES  
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12           *Ex parte* ERIK KRIMM and MICHAEL SIEMERS  
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15                   Appeal 2007-2003  
16                   Application 09/726,589  
17                   Technology Center 3600  
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20                   Decided: August 3, 2007  
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23     Before WILLIAM, F. PATE, III, HUBERT C. LORIN, and STUART S. LEVY,  
24     *Administrative Patent Judges.*

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26     PATE, III, *Administrative Patent Judge.*  
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29                   DECISION ON APPEAL  
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32                   STATEMENT OF THE CASE

33           This is an appeal from the final rejection of claims 1, 4, 8, 20, 24, and 25.  
34     Claims 2, 3, 9-19, 21-23, and 26-32 have been canceled. The Examiner has

1 indicated that claims 5-7 are directed to allowable subject matter. We have  
2 jurisdiction under 35 U.S.C. §§ 134 and 6(b).

3 The claimed invention is a gate plate for an automatic gear shift mechanism  
4 in an automotive vehicle with an automatic transmission. The gate plate is in the  
5 automatic transmission gearshift housing and is where the gearshift mechanism  
6 interfaces with various interlocks including the neutral safety switch. Appellants'  
7 gate plate is made of three stamped steel plates sandwiched together, with the  
8 metal plate having pre-applied thereon an elastomeric moldable substance.

9 Claim 1 reproduced below is further illustrative of the claimed subject  
10 matter:

11 1. A functional component as a gate plate of an automatic gear shift  
12 mechanism with a locking gate, having engagement holes for engagement  
13 elements which kinetically interact with the functional component, wherein  
14 the functional component comprises at least three stamped parts, which lie  
15 flat sandwiched against one another, are unreleasably connected to one  
16 another and each have at least two engagement holes for engagement  
17 elements which kinetically interact with the functional component, the  
18 engagement holes in the stamped parts being arranged congruently with  
19 respect to one another, at least one of said holes, in a middle one of the  
20 stamped parts, having a hole wall which is provided with an elastomeric  
21 plastic cover.

22 The reference of record relied upon by the Examiner as evidence of lack of  
23 novelty is:

24 Sander US 6,182,527 B1 Feb. 6, 2001  
25 (102(e) filing date: Jul. 2, 1999)

Clams 1, 4, 8, 20, 24, and 25 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Sander.

# ISSUE

The issue raised by this appeal is the Examiner's rejection of the claims on appeal as lacking novelty over Sander. Subsidiary issues are raised by Appellants resort to a Declaration under 37 C.F.R. § 1.131 to antedate the Sander reference. These issues include whether Appellants' claims on appeal and Sander are directed to the same patentable invention, and whether Appellants' § 1.131 Declaration is ineffective for lack of proof of diligence as alleged by the Examiner.

## FINDINGS OF FACT

Appellants have not argued that the subject matter of Sander fails to anticipate the subject matter of Appellants' claims on appeal. Therefore we hold, with the Examiner, that the subject matter of Appellants' claims on appeal lacks novelty over the subject matter disclosed by Sander.

Instead, Appellants argue that the Declaration submitted under 37 C.F.R. § 1.131 provides evidence which antedates the effective date of the Sander disclosure. The Examiner argues that the Rule 131 showing is ineffective for three reasons. First, the Examiner states that the Declarants have not provided evidence that the invention was made in a country that is a signatory to the NAFTA or WTO treaties. We agree with the Examiner that it is incumbent upon Appellants to provide evidence that the invention was made in such a country. We find it to be little burden on the Declarants to state what country they did their work in. Consequently, we sustain the Examiner's holding that the showing under 37 C.F.R.

1 § 1.131 is ineffective for providing no evidence concerning the country in which  
2 the invention was made.

3 The Examiner secondly raises the issue of diligence. The Declarant state  
4 that they were diligent from July 2, 1999 to December 1, 1999. No other facts,  
5 dates, or activities are alleged. Diligence is a question of fact. *In re Jolley*, 308  
6 F.3d 1317, 1326, 64 USPQ2d 1901, 1908 (Fed. Cir. 2002). A party that seeks to  
7 establish reasonable diligence must account for the entire period in which diligence  
8 is required; that period commences from just prior to the date upon which its  
9 opponent entered the field until the date of the party's reduction to practice, either  
10 actual or constructive. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634,  
11 643 (CCPA 1966). Evidence which is of a general nature to the effect that work  
12 was continuous, and which has little specifics as to dates and facts does not  
13 constitute the kind of evidence required to establish diligence in a critical period.  
14 *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949). In a 37  
15 C.F.R. § 1.131 context see *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193  
16 (Fed. Cir. 1983), where the want of any showing of diligence during a two day  
17 critical period prevented an applicant from establishing a date of invention prior to  
18 a publication cited as prior art.

19 In this instance, there is simply no evidence of specific dates or activities  
20 that establish that Appellants were diligent in making the invention either based on  
21 the activities of a legal representative or through their own acts or acts that inure to  
22 them.

23 As to the last issue raised by the Examiner, that is that Appellants and  
24 Sander are claiming the same patentable invention under 37 C.F.R. § 1.131, we

must disagree with the Examiner. The Patent Office requires a “two way” test in the context of interfering subject matter. *See Winter v. Fujita*, 53 USPQ2d 1234, 1243 (Bd. Pat. App. & Int. 2000) and *Eli Lilly & Co. v. Bd. of Regents of Univ. of Washington*, 334 F.3d 1264, 1268, 67 USPQ2d 1161, 1163-64 (Fed. Cir. 2003). This two way unpatentability test has been codified in 37 C.F.R. § 41.203(a). Nothing in the claims of Sander would have anticipated or rendered obvious the stacked limitation argued by Appellants and found in the claims on appeal. Accordingly, the two way test is not satisfied in this instance, and Appellants cannot be held to be claiming interfering subject matter under 37 C.F.R. § 1.131.

#### CONCLUSION

For the foregoing reasons, Appellants have failed to antedate the filing date of the applied Sander prior art. Accordingly, we hold that Sander anticipates Appellants’ claims on appeal. The rejection of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

#### AFFIRMED

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